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IN THE

Supreme Court of the United States

October Term, 1958

No. 832

WILLIAM DUBILIER,

Petitioner,

vs.

THE UNITED STATES.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

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No.

WILLIAM DUBILIER,

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THE UNITED STATES.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

Petitioner, William Dubilier, prays that a writ of certiorari issue to review the judgment of the United States Court of Claims entered in the above entitled case on January 14, 1959.

Opinion Below

The Opinion of the Court of Claims is reported at 169 F. Supp. 489.

Jurisdiction

The judgment of the Court of Claims was entered on January 14, 1959. The jurisdiction of this Court is invoked under 28 U. S. C. 1255.

Questions Presented

1. Where a complex technical invention took six days of expert testimony of skilled electrical engineers, directed exclusively to validity and infringement, must the Court as a matter of law accept undisputed testimony or may it conclude non-infringement on "facts" of its own knowledge outside the record and contrary to the undisputed testimony.

2. Did the Court below err in law in evading judgment on patent invalidity.

Statutes Involved

Article I, Sec. 8 of the Constitution of the United States, relating to granting of patents and Title 28 U. S. C. 1498, relating to reasonable compensation for unlicensed use of a patented invention, are here involved.

Statement

The Geffcken et al. patent 1,898,046 (hereinafter referred to as Geffcken) here involved, is for a "thyratron" i.e., a gas filled tube used for switching electrical currents on and off. It effects this switching by an involved technical phenomenon known as "ionization" of the gas in the tube. When the gas is not "ionized", the tube does not conduct. When the gas is "ionized", the tube conducts electricity.

The thyratron has become an important electrical device, widely used in industry and in military devices. The Radio Corporation of America paid $300,000 for license rights from Petitioner for about 300 patents, including this patent here in suit. The American Telephone & Telegraph Company also purchased a license for a similar large sum

(R. 19, Exhibits 1, 9)*. These 300 patents (including the patent here chosen by Petitioner to test all the patents) will by stipulation with respondent be licensed free to the Government if as a result of this litigation the Government pays for its use of the Geffcken patent.

The trial lasted six days during which eight witnesses testified, all of them electrical engineers, specialists in the field of this invention.

Petitioner presented undisputed testimony of electrical engineers expert in this field that the Geffcken patent was the first to teach how to make a successful thyratron (R. 550), after fruitless years of effort to produce a thyratron by General Electric engineers (R. 74, 75, 79) such as Langmuir, Nobel Prize Winner (Patent 1,289,823), and Peter Cooper Hewitt (Patent 1,402,931) etc. Both Plaintiff's and Defendant's experts agreed that these prior attempts at a thyratron had serious practical limitations (R. 452, 504, 511). Immediately following the disclosure of the Geffcken thyratron, the industry published papers thereon and proceeded to manufacture thyratrons.

Respondent first presented thirty-nine prior art citations, but at the trial relied on fifteen of these patents. It sought to show invalidity by different combinations of these patents. The Commissioner found invalidity by his own combinations, not established at the trial.

The Commissioner found the patent invalid:

1. On new matter (arc) in Figure 3 of the patent (Commissioner's Finding 10), but Defendant presented no testimony on this with respect to Figure 3. Plaintiff's undisputed technical testimony was that Figure 3 must inherently arc.

2. Incomplete disclosure (Commissioner's Finding 11) —but the only testimony (in this instance by both Plaintiff

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*R. refers to the pages in the record of the testimony.

and Defendant R. 203-208, 216-223, 335) was that the patent disclosure is complete.

3. On several combinations of references (Commissioner's Findings 28, 29, 30, 31, 32, 33)—but there was no testimony on those particular combinations selected by the Commissioner.

4. The Commissioner found the patent non-infringed (Commissioner's Finding 36), but the undisputed testimony showed each element of the claim in the accused structure . . .

In none of these Findings did the Commissioner refer to the record for support when he made Findings contrary to the undisputed testimony.

Accordingly, Plaintiff urged in his brief below that if the Court adopts the Commissioner's Findings, it should refer to the record for support: that in the alternative, these created issues of law, namely that in this technical art the Commissioner as a matter of law must adopt the undisputed testimony.

The Court in its opinion said it was "unnecessary to consider such (validity) issues in our disposal of this litigation", page 5, last lines of the opinion; i.e. it did not consider the first three groups above dealing with validity because it found the patent non-infringed.

In so simplifying the issue to a single infringement issue, the Court did not refer to the record to support its holding on infringement; did not show how it arrived at "facts" contrary to the undisputed testimony; nor did it discuss the issue of law thus raised by Petitioner.

REASONS FOR GRANTING THE WRIT

ISSUE 1

Where a complex technical invention took six days of expert testimony of skilled electrical engineers, directed exclusively to validity and infringement, must the Court, as a matter of law, accept undisputed testimony, or may it conclude non-infringement on "facts" of its own knowledge outside the record and contrary to the undisputed testimony?

(1) It is elementary that where there is conflicting fact testimony, it is the Court's task to evaluate the relative merit of such testimony. A party may disagree, but he is bound by the relative weight the Court has placed on such conflicting testimony.

Here, however, Plaintiff predicated its entire case on the ground that there is no conflicting testimony to compare.

We submit the following example: In concluding non-infringement, the Court must refer to at least one element of the claim not found in the accused structure. Thus, the Court found that the structure does not respond to the specific recital of claim 18

> "which specifically recites a potential means in the output circuit for alternately starting and stopping the electrical discharge in said device." (p. 3, lines 23 to 27)

But the only testimony is:

> "Q. Do you find potential means in said output circuit for alternately starting and stopping the electrical discharge in said device? A. Yes. . . . The cojoint action of the shunt condenser 121 and the series resistor R-119 effectuates the alternate starting and stopping of the discharge tube V-107 during its firing state, namely, when the tube would tend to

> or want to conduct, it is alternately interrupted by those two elements I just stated, C 121 and R 119 which, incidentally, is done in a manner to also create a pulse signal through transformer T 10[illegible] primary, which in turn actuates the upper portion of the circuit, Figure C-1, as the Government witness yesterday very clearly and ably set forth." R. 146, 147

If there is testimony disputing the above testimony and supporting the Court's Finding that the accused structure "does not respond to the specific recital of Claim 18 (p. 3, line 9 from bottom)", it will be a simple matter for Defendant to refer to such testimony. However, when previously challenged to do so, Respondent substituted a debate, based on his erroneous "facts", for the absence of testimony.

(2) It was no inadvertence that the Court did not undertake in its twenty-six page opinion to show error by Plaintiff by referring to the record for support of its "facts", although Plaintiff made the Court's inability to do so a major issue in its brief below.

The Court

(1) could not rely on or refer to Defendant's testimony, for Defendant introduced no testimony in support of the "facts" relied on by the Court.

(2) could not refer to Plaintiff's testimony, since this testimony presented facts directly contrary to those relied on by the Court.

Neither the Commissioner nor the Court, despite their sole reliance on their own technical knowledge in this specialized field, tried to establish themselves as experts in the specialized field of thyratrons.

On the other hand, trained engineers, specifically skilled in this field, did testify for six days. Plaintiff presented the testimony of (1) an electrical engineer who has spent his entire professional life of twenty-five years in the spe-

cial field of this invention, and is presently employed as Chief Engineer; (2) a former University of Pennsylvania professor of electrical engineering, author of four authoritative technical books including the subject of the present invention and whose experience in the field of this invention goes back to before the 1920's; (3) an electrical engineer and patent expert of twenty years experience; and (4) three electrical engineers, employed by the United States Government in the use of the arc discharge tubes (thyratrons) here in issue. These three engineers were suggested by the Government as working on thyratrons. They were, therefore, subpoenaed.

Defendant presented the testimony of: (5) an electrical engineer employed by the Government in the field of the thyratrons here in issue; and (6) a distinguished retired Navy Captain who is also an electrical engineer and a well known patent expert.

We cite here this formidable group of highly qualified technical witnesses for, incredible as it may seem, this Court will study the Commissioner's Findings and the Court of Claims decision in vain for a single use of or reference to the facts of validity and infringement developed by any of these witnesses.

(3) The Court did not find the element missing by "evidence" presented at the trial disputing Plaintiff's testimony.

The Court therefore to conclude non-infringement had to find as "facts" that this element is not present in defendant's thyratrons, on "evidence" other than that presented at the trial.

Plaintiff was not confronted with such "evidence" and so has been denied his right of cross-examination of the "testimony" on which these "facts" are based.

What is said in the above example on "potential means • • • " testimony applies equally well to the remaining por-

tions of the opinion. However, it is not necessary to go further here to other claims, for to establish infringement it is sufficient if one claim is infringed.

(4) Although the Court in concluding non-infringement states on Page 3, lines 19-25: "We find it unnecessary to consider such (validity) issues in our disposal of this litigation", the Court went on to adopt the Commissioner's Findings on invalidity.*

As to these Findings, Plaintiff also submitted in its brief below, issues of law predicated on the undisputed testimony of Plaintiff and the absence of any instance of testimony by Defendant in support of these Findings.

One such issue of law was stated as follows:

1. Where a patentee's drawings show circuit diagrams which, by undisputed testimony supported by basic laws of physics inherently must operate as arc discharge, does it render his patent invalid for "new matter" when he amends his specification to recite "arc discharge" (raised with respect to Finding 10, page 16 of the Court's decision)?

In support of this issue of law, Plaintiff-petitioner cited *Eames* v. *Andrews*, 122 U. S. 55-56; *Safway Steel Scaffolds Co. of Wisconsin* v. *The Patent Scaffolding Company*, 110 2d 108 (cert. denied 311 U. S. 671); *Nichols* v. *Minnesota Mining & Mfg. Co.*, 109 F. 2d 162, where the Court called attention to the Supreme Court language:

> "It is a method and device which may be patented and not the scientific explanation of their operation. DeForest Radio Co. v. General Electric Co., 283 U. S. 664, 684-685."

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* It is now more than fifteen years since this Court has granted certiorari from the Court of Claims on a suit dealing with validity and infringement questions, the last such case being *Marconi Wireless* v. *U. S.*, decided June 21, 1943, in an opinion written by Justice Stone.

In adopting this Finding, the Court does not make any mention of this sole legal ground raised by Petitioner.

The issue here is not whether the Court's evaluation of the facts established by testimony is correct, but rather whether undisputed testimony in a complex technical invention is not binding on the Court.

That there is undisputed validity and infringement testimony here is established by the failure of the Court or the Defendant in response to Petitioner's challenge to indicate where in the record there is such disputing testimony.

As Petitioner has shown, all that Respondent need do to overcome the basic argument here is to refer to at least a word of testimony by Defendant's experts to the effect that there is not in the Government devices a "potential means in said output circuit for alternately starting and stopping the electrical discharge in said device".

The Law on Undisputed Testimony.

The general rule in the Federal Courts is that uncontradicted testimony, not impeached or discredited in any way respecting plain and simple facts, ordinarily must be accepted as true. A cogent statement of the rule citing *Kelly v. Jackson*, 6 Pet. 622, 631, is found in *George* v. *Capital Traction Co.*, 295 Fed. 965 at 968 stating:

> "• • • Where the testimony is all one way, and not immaterial, irrelevant, improbable, inconsistent, contradicted or discredited, such testimony cannot be disregarded or ignored by judge or jury, and if one or the other makes a finding which is contrary to such evidence, or which is not supported by it, an error results for which the verdict or decision, if reviewable, must be set aside • • •.
>
> To hold otherwise would vest triers of the facts in cases subject to review with authority to disregard the rules of evidence which safeguard the liberty and estate of the citizen."

See also: *Cullers* v. *Commissioner*, 237 F. 2d 611 (C. C. A. 8th, 1956); *Estate of Fitts* v. *Commissioner*, 237 F. 2d 729 (C. C. A. 8th, 1956); *Planters Operating Co.* v. *Commissioner*, 55 F. 2d 583 (C. C. A. 8th, 1932); *Capitol-Borg Dry Cleaning Co.* v. *Commissioner*, 131 F. 2d 712 (C. C. A. 6th, 1942); *Pittsburgh Hotels Co.* v. *Commissioner*, 43 F. 2d 345 (C. C. A. 3d 1930); *Boggs* v. *Buhl, Inc.* v. *Commissioner*, 34 F. 2d 859 (C. C. A. 3d 1929); *Diamond Alkali Co.* v. *Heiner*, 60 F. 2d 505 (C. C. A. 3d 1932); *Ansley* v. *Commissioner*, 217 F. 2d 252 at page 256.

In *Loesch & Green Construction Co.* v. *Commissioner*, 211 F. 2d 210 (C. C. A. 6th, 1954), the Court reversed the Tax Court which failed to accept the uncontradicted testimony of experts as to reasonableness of salaries. The Court stated at page 212:

> "Their testimony was unimpeached and should have been accepted by the Tax Court in a matter in which it had no knowledge or experience upon which it could exercise independent judgment; and such evidence cannot be arbitrarily disregarded * * *. Petitioner's witnesses were qualified, unimpeached and no evidence was given to the contrary. Their testimony should have been accepted."

Petitioner submits this rule is particularly apt where, as here, the testimony is technical and experts fail to dispute the testimony.

ISSUE 2

Did the Court below err in law in evading judgment on patent invalidity.

This Court in *Sinclair and Carroll Co.* v. *Interchemical Corp.*, 325 U. S. 327, decided 1945, in approving the practice of the District Judge in passing on both validity and infringement said:

> "There has been a tendency among the lower federal courts in infringement suits to dispose of them

> where possible on the ground of non-infringement without going into the question of validity of the patent. Irwin v. Buick Motor Co., 88 F. 2d 947, 951; Aero Spark Plug Co. v. B. G. Corp., 130 F. 2d 290; Franklin v. Masonite Corp., 132 F. 2d 800. It has come to be recognized, however, that of the two questions, validity has the greater public importance, Cover v. Schwartz, 133 F. 2d 541, and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent."

Since this decision, some of the Circuits have followed this rule, usually giving the same and further reasons. Thus, the Ninth Circuit Court of Appeals, remanding a case to the District Court for an opinion on validity, in *Helbush* v. *Finkle* (CA 9), 170 F. 2d 41, said in citing the above Supreme Court case:

> "Usually where the question of validity is raised in a patent infringement case, the District Court should determine that question before determining the question of infringement. That of course should have been followed in this case."

It went on to say:

> "There may be cases in which non-infringement is so apparent as to make it unnecessary to determine the question of validity. This, however, is not such a case."

See also *Vischer Products Co.* v. *National Pressure Cooker Co.* (CA 7), 178 F. 2d 125; *W. F. & John Barnes Co.* v. *International Harvester Co.* (D. C. N. Ill.), 51 F. Supp. 254; *Madison Patent Corp.* v. *Harry Williams Mfg. Co.* (D. C. N. Ill.), 87 F. Supp. 87; *Sunlite Mfg. Co.* v. *Claravan* (D. C. E. Wis.), 73 F. Supp. 938; *Avery* v. *Ever Ready Label Corp.* (D. C. N. J.), 104 F. Supp. 913; *Lyons* v. *Construction Specialties Inc.* (D. C. N. J.), 112 F. Supp. 317.

On the other hand, a District Court Judge of Northern Illinois in *Brunswick-Balke-Collender Co.* v. *Kuehne Mfg. Co.*, 110 U. S. P. Q. 481, felt that "generally it is a good rule not to consider validity unless infringement is found". See also *Paley* v. *Bethlehem Steel Co.* (DC Mass.), 114 F. Supp. 579.

The Court of Claims also does not follow the Supreme Court rule, *supra*. In *Ferguson* v. *U. S.*, 65 F. S. 580, the Court of Claims said:

> "Since there is no infringement, it is unnecessary for the Court of Claims to discuss validity."

In the instant case the Court of Claims, concluding non-infringement, finds it unnecessary to consider such validity issues "in our disposal of this litigation", Opinion page 5, line 23.

When competent patent counsel is asked for an opinion on infringement, it is the practice to first determine from the prior art the scope of the invention. Only thus can a reasonably accurate evaluation of infringement be made by patent counsel skilled in this field. Here the Court found that the Government thyratrons do not have potential means in said output circuit for alternately starting and stopping the electric discharge.

Had the Court considered validity, it would have learned from examining the prior art that this feature indeed is not new with Plaintiff's patent: it is and has been an inherently necessary element in all gas arc discharge tubes.

While it may be possible, as the courts have stated, to determine infringement without first considering validity, this is only possible in a very simple device. It has never been found possible by patent counsel in a complex and highly technical device. It would hardly seem possible for a Judge to pass on infringement without first considering validity in so complex a device as a thyratron. Moreover,

the considerations of validity include the facts which must be known in determining infringement.

Moreover, if this Court in reviewing this Petition concludes there is merit here, it may remand this case to the Court below for an opinion on validity thus repeating the work the Court has already gone through, to say nothing of the work and cost to the parties here involved.

It is respectfully submitted that:

1. The precedent here established that a defendant need not assume any burden after plaintiff has made a word for word application of the claim to the infringing device; that defendant need not subject its witnesses to cross-examination by introducing testimony disputing Plaintiff's fact testimony, relying solely on establishing "facts" by debate in its brief after the trial, is a denial of Plaintiff's judicial right to a trial on the facts.

2. The growing practice of passing on infringement without first considering validity can, and in technical inventions often does result in a miscarriage of justice. This has happened here where the Court found that an element without which a thyratron cannot work, was for some unknown reason not used by the Government thyratron, although undisputed testimony was presented that the element is present.

It is respectfully petitioned that the writ of certiorari be granted.

Respectfully submitted,

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APPENDIX

(Word for word application of Claim 18 as taken directly from the testimony, pages 144-148 inclusive.)

Q. Now, Mr. Marsen, I hand you Plaintiffs' Exhibit No. 3 and I also hand you Plaintiffs' Exhibit No. 2 and now in connection with Plaintiffs' Exhibit No. 3 and Plaintiffs' Exhibit No. 2, which is the response of the Air Force to Plaintiffs' call, I would like you to consider as a sample claim, Claim 18, and as I read the elements of Claim 18 I would like you to apply it to Plaintiffs' Exhibit No. 3 and to Plaintiffs' Exhibit No. 2.

Did you have anything to do with the preparation of the drawings shown on Plaintiffs' Exhibit No. 3? A. Yes, I laid out the diagram as close and exact as I could from the corresponding portions of the Exhibit No. 2 and a draftsman prepared it therefrom.

Q. Now, considering both Plaintiffs' Exhibit No. 2, and Plaintiffs' Exhibit No. 3, do you find in them an electrical system comprising an input circuit carrying weak controlling currents? A. Well, I find many but I would like to refer to Figure G-2 of Exhibit No. 3 as a typical application unless you want more. I am looking for that exact tube now, V107.

Q. Does the Court appreciate now I am reading Claim 18?

Commissioner Lane: Yes.

The Witness: That shows that that corresponds to this figure here. There are many more like it but I see the same lettering and legends as appear on Figure G-2 of Exhibit No. 3, which would make it easier to follow and record.

By Mr. Ostrolenk:

Q. Do you find an output circuit to carry heavy controlled currents in these Exhibits Nos. 2 and 3? A. Well, we have in tube V107 the circuit of Figure G-2 and is the portion of the main system of Exhibit No. 2, and the elec-

trical system therein has the tube V107 with its input and output circuits, and when a gaseous tube is involved or as the corresponding tracing through of such circuits would show and does show, there are the weak currents in the input and the heavy currents which are controlled thereby in the output of the tube V107.

A portion of the Exhibit No. 2 indicated and drawn as a portion of Figure G-2 of Exhibit No. 3 corresponds to such system with the weak input and the output controlled currents.

Q. Do you find an electrical discharge device filled with a gaseous atmosphere in these two exhibits? A. Yes, the V107 is such a gaseous atmosphere device and electrical discharge device. It is type 5727 as indicated on both exhibits, and the conventional dot confirms the statement.

Q. Confirms the statement that it is filled with gaseous atmosphere? A. Confirms my statement, yes.

Q. Do you find main electrodes situated within said device and connected in said output circuit? A. Yes, the main electrodes are the cathode connected to terminal 2 of tube V107, and the anode of plate connected to plate terminal 6, which terminals 2 and 6 are not indicated on Exhibit No. 3 but appear on Exhibit No. 2.

The output circuit includes the pulse transformer primary T101P, and the anode is connected with the cathode to such output circuit.

Q. Do you find potential means in said output circuit for alternately starting and stopping the electric discharge in said device? A. Yes. The operation of the gaseous discharge tube V107 connected to the DC supply line which extends from 550 and actually is 571 connected by a relay, contacts K108 in the Exhibit No. 2—it doesn't appear in Exhibit No. 2 and Exhibit No. 3—such DC supply to the thyratron or gaseous discharge tube V107 is interrupted through the tube V107, ultimately through the resistor R119 and capacitor arrangement directly across the main electrodes, namely, condenser C121.

The co-joint action of the shunt condenser C121 and the series resistor R119 affectuates the alternate starting

and stopping of the discharge tube V107 during its firing state, namely, when the tube would tend to or want to conduct, it is alternately interrupted by those two elements I just stated, C121 and R119, which, incidentally, is done in a manner to also create a pulse signal through transformer T101 primary, which in turn actuates the upper portion of the circuit Fig. G-1 as the Government witness yesterday very clearly and ably set forth.

Q. Do you find an auxiliary electrode within said device? A. Yes, the auxiliary electrode is the grid structure adjacent the cathode in the Exhibit No. 3 and Exhibit No. 2, and as indicated by a dashed line connected to Terminal 1 of tube V107.

Q. Do you find said input circuit being connected to said auxiliary electrode? A. Yes, the input circuit is connected to the auxiliary electrode, and in Fig. G-2 of Exhibit No. 3 we note from terminal C that the control signal input through appropriate resistors does connect to the grid electrode.

Q. Do you find an electric reactance connected to said auxiliary electrode and to said input circuit to be charged by the controlling currents in said input circuit for producing input potential upon said auxiliary electrode for controlling the electrical discharge of said device? A. Yes, such component is the condenser C112 connected to the auxiliary electrode of tube V107 as well as the input circuit which also connects thereto, and such condenser is charged by the signals in a manner to produce the stated operation which affectuates an electrical discharge of the tube V107 at the proper time.

Mr. Ostrolenk: I have had the witness apply typical claims to different units in actuality from his testimony. The remaining claims which are here involved are applicable to practically all of the devices in about the same manner. It would merely be a matter of duplication to continue upon each claim on each of the calls and I turn him over for cross-examination.

(Opinion of United States Court of Claims)

RADIO PATENTS CORPORATION, PATENTS RESEARCH CORPORATION, RADIO CORPORATION OF AMERICA, and WILLIAM DUBILIER,

v.

UNITED STATES.

No. 50216.

UNITED STATES COURT OF CLAIMS.

Jan. 14, 1959.

LARAMORE, *Judge.*

This is a suit for patent infringement. The Geffcken & Richter patent No. 1,898,046, hereinafter referred to as Geffcken, issued to plaintiff Radio Patents Corporation on February 21, 1933, and is now expired. Plaintiffs contend that claims 2, 7, 11, 15, 16, and 18 of the Geffcken patent have been infringed by certain electronic equipments used by defendant. Defendant contends that the patent claims in suit have not been infringed by the accused equipments and that the claims are not valid.

The subject of the Geffcken patent is "Electric Relay Device for Indicating Weak Currents." In general, this patent describes a cold cathode arc discharge delay device and circuits therefor. The technological principles involved may be briefly summarized as follows. An electrical relay is a device for controlling a flow of electricity in response to some signal. Such relays include various types of electronic tubes operated to control the flow of a current of electrical particles, called electrons, through the tube. Electronic relay tubes may be gas-filled or may be evacuated. Gas-filled tubes contain some gas which when ionized provides a path for the flow of electricity. Such gas-filled

tubes having three electrodes are commonly known as thyratrons. Evacuated electron tubes generally include thermionic means, such as a heated filament, to emit electrons which provide the path for the flow of electricity through the tube. An arc discharge is a luminous bow of light between two electrodes and passes a relatively high value of electric current at low voltages. A glow discharge is a luminous glow or haze between two electrodes and passes minute values of electric current at relatively high voltages.

Plaintiffs contend that the Geffken invention comprised the using of a cold cathode and an external circuit which makes the cold cathode arc. Plaintiffs contend that such a system revolutionized the thyratron art. The several patent claims upon which plaintiffs rely define the precise scope of the alleged invention. It is the claim language which we must first consider. The claims in suit are set forth in full in the accompanying findings. Claim 2 recites an arc-electrical relay device comprising a gas discharge tube, solid cathode and anode electrodes, and an auxiliary electrode between the main electrodes. The claim specifies that the main electrodes are connected to a source of energy too low to produce ionization and discharge, and also specifies means to impose an auxiliary potential on the auxiliary electrode and further means to impose a controlling potential on the auxiliary electrode, the latter controlling potential resulting in ionization and in arc discharge between the auxiliary electrode and the cathode which initiates a discharge between the main electrodes. Claim 7 is generally similar to claim 2 and recites that the tube is glass and the electrodes fixed. Claim 7 does not specify an arc device but defines a device for switching considerable current which seems to us to imply an arc discharge type of device. Claim 15 is also similar to claim 2 and recites a vessel filled with a uniform gaseous atmosphere. Claims 11, 16, and 18 recite electrical systems including input and output circuits. Claim 11 recites that the system includes high ohmic re-

sistance in series with the main electrodes and a condenser in parallel with said electrodes. Claim 16 includes a reactance associated with the input circuit. Claim 18 adds potential means in the output circuit for alternately starting and stopping the electrical discharge.

Although plaintiffs urge that Geffcken relates to an electrical switch which turns current on and off, our consideration of the claim language indicates that the alleged invention is not that simple. The claim language is specific in pointing out the metes and bounds of the patent grant, and may not be broadened to cover a variety of different devices and systems used by defendant.

The accused thyratron controller used by defendant's Department of the Air Force and illustrated diagrammatically in General Electric wiring diagrams, plaintiffs' exhibits 2 and 3, is a complex circuit of apparatus for automatically controlling the azimuth and elevation of a turret in response to applied error signals. The thyratrons *V107-V112* used therein are gas-filled tubes each having an anode, two grids, a cathode and a separate thermionic filament. Plaintiffs urge that use of tube *V107* and its associated circuits infringes Geffcken claim 18. This claim specifically recites a potential means in the output circuit for alternately starting and stopping the electric discharge in said device and recites an electric reactance connected to the auxiliary electrode and to the input circuit to be charged. The accused controller is complex in that it utilizes a three-phase alternating current supply for producing rotation of azimuth and elevation motors in both directions of rotation. We are not able to find any basis for departing from our trial commissioner's finding that this controller circuit does not respond to the specific recital of claim 18, and likewise does not respond to the recital of other claims in suit. We note that tube *V107*, as well as numerous other thyratrons in the controller circuit, utilizes thermionic filaments in some instances as the tube cathode and in others the filament is separate from the cathode. In either case, it appears that a hot filament serves as an emit-

ter of electrons and provides for circuit and tube operation of a character specifically different from the cold cathode type of operation disclosed by Geffcken and stressed by plaintiffs.

The accused Rawin elevation drive motor control circuit, plaintiffs' exhibit 5, used by defendant's Department of the Army, includes type *3C22* thyratrons and associated circuitry. These tubes contain a mixture of an inert gas and mercury, and each tube has an anode, a control grid, and a filamentary thermionic cathode. Plaintiffs urge that use of such a tube and its circuit infringes Geffcken claim 15 which recites, among other limitations, that the tube (vessel) is filled with a uniform gaseous atmosphere. While the Geffcken specification is silent as to the intended meaning of uniform gaseous atmosphere, we note that counsel in presenting this claim to the Patent Office argued that it is essential that the gaseous condition within the tube remain absolutely stable and uniform and that such operation cannot be obtained with mercury pool cathodes. We conclude that claim 15 is not infringed by defendant's circuit utilizing thyratrons containing mercury and a hot filamentary cathode. We likewise conclude that the Rawin apparatus does not infringe the other claims in suit.

The accused Auxiliary Control Panel circuit, plaintiffs' exhibit 10, used by defendant's Department of the Navy, includes a relay tube, Western Electric *313CA*, containing a cold cathode, two control electrodes, an anode, and described as a vacuum tube. A vacuum tube is a sealed tube with the contained gas exhausted to a pressure low enough to permit the passage of electric discharges between metallic electrodes therein. Plaintiffs urge that use of the *313CA* tube and its circuit infringes Geffcken claim 2. This claim recites an arc discharge device including an auxiliary electrode between the main electrodes and also recites auxiliary potentials and controlling potentials. Plaintiffs urge that tube *313C.f* is not a vacuum tube of the type disclaimed by plaintiffs at trial. In objections to defend-

ant's requested findings, plaintiffs urged that the characteristics of the *313CA* tube, shown in plaintiffs' exhibit 20 for glow discharge operation, are such that the tube when used in defendant's auxiliary control panel circuit might operate in arc discharge and would need to operate thus only once. It is our opinion that the accused panel circuit with tube *313CA* does not respond to the specific recital of claim 2 in the manner urged by plaintiffs, and likewise does not respond to the specific recitals of the other claims in suit.

[1] In reaching our conclusion that each of the several claims in suit is not infringed by any of the several currently accused thyratron tubes and associated circuits used by defendant, we have not been unmindful of the testimony of plaintiffs' witnesses. Consideration of the statements of all witnesses with respect to operation of the several accused circuits and their component parts convinces us that the accused equipments do not include each and every element and applied potential specified in the claims in suit, and that such apparatus does not function to produce the same results as delineated in the Geffcken patent specification.

[2] In view of the fact that we have concluded that the patent claims in suit have not been infringed by defendant, we need not pass upon the validity of the Geffcken patent. Noting that defendant has urged a number of prior patents and prior publications as invalidating the claims in suit, and has also urged invalidity based on alleged defects in and alleged inoperativeness of the Geffcken application disclosures, we find it unnecessary to consider such issues in our disposal of this litigation.

The petition is dismissed.

It is so ordered.

JONES, Chief Judge, and MADDEN and WHITAKER, Judges, concur.

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Office Supreme Court, U.S.
FILED
APR 13 1959
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

October Term, 1958

No. 8320

WILLIAM DUBILIER,

Petitioner,

vs.

THE UNITED STATES.

STATUTES INVOLVED IN PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

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New York City.

OSTROLENK, FABER, GERB & SOFFEN,
of Counsel.

Article I, Section 8 of the Constitution of the United States

The Congress shall have Power * * * to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; * * *.

28 U. S. Code 1255, Court of Claims—Certiorari—Certified Questions

Cases in the Court of Claims may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted on petition of the United States or the claimant;

(2) By certification of any question of law by the Court of Claims in any case as to which instructions are desired, and upon such certification the Supreme Court may give binding instructions on such question.

28 U. S. Code 1498, Patent Cases

Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the Court of Claims for the recovery of his reasonable and entire compensation for such use and manufacture.

For the purposes of this section, the use or manufacture of an invention described in and covered by a patent of the United States by a contractor, a subcontractor, or any person, firm, or corporation for the Government and with the authorization or consent of the Government, shall be construed as use or manufacture for the United States.

The court shall not award compensation under this section if the claim is based on the use or manufacture by or for the United States of any article owned, leased, used by, or in the possession of the United States prior to July 1, 1918.

A Government employee shall have the right to bring suit against the Government under this section except where he was in a position to order, influence, or induce use of the invention by the Government. This section shall not confer a right of action on any patentee or any assignee of such patentee with respect to any invention discovered or invented by a person while in the employment or service of the United States, where the invention was related to the official functions of the employee, in cases in which such functions included research and development, or in the making of which Government time, materials or facilities were used.

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FILED
MAY 7 1958
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No. 832

In the Supreme Court of the United States

OCTOBER TERM, 1958

WILLIAM DUBILIER, PETITIONER,

v.

THE UNITED STATES

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

BRIEF FOR THE UNITED STATES IN OPPOSITION

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In the Supreme Court of the United States

OCTOBER TERM, 1958

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THE UNITED STATES

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

BRIEF FOR THE UNITED STATES IN OPPOSITION

OPINION BELOW

The opinion of the Court of Claims (Pet. 18-22) is reported at 169 F. Supp. 489.

JURISDICTION

The final judgment of the Court of Claims was entered on January 14, 1959 (R. 49).[1] The petition for a writ of certiorari was filed on April 13,

[1] "(R.)" references are to the certified Transcript of Record; "(Tr.)" references are to the Transcript of Testimony.

1959.[2] The jurisdiction of this Court is invoked under 28 U.S.C. 1255(1).

QUESTIONS PRESENTED

1. Whether the Court of Claims erred in finding that the petitioner's evidence failed to establish an infringement of his patent claims by the Government's use of certain equipment and devices.

2. Whether the Court of Claims was precluded, as a matter of law, from disposing of an infringement suit on the ground of non-infringement, without considering the question of the validity of the patent, where the patent had expired prior to the institution of the suit.

STATEMENT

This suit was instituted on July 2, 1951, pursuant to 28 U.S.C. 1498,[3] to recover compensation for the

[2] The suit was filed in the Court of Claims in the name of Radio Patents Corporation, Patents Research Corporation, Radio Corporation of America, and William Dubilier, the latter being the sole petitioner here (R. 1). In accordance with a stipulation of the parties, the charge of infringement was restricted to a single patent issued to the Radio Patents Corporation, and the court found, as stipulated, that that corporation "was a party to this suit when filed and was the true party in interest thereto." (R. 53-54). Although not shown by the record, it is our understanding that petitioner is or was the sole stockholder of the corporation. We have no information as to why the petition has been filed in his name only.

[3] 28 U.S.C. 1498 provides in pertinent part:

> "Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the Court of Claims for the recovery of his reasonable and entire compensation for such use and manufacture."

unlicensed use by the Government of certain electronic equipment allegedly covered by six claims of patent No. 1,898,046 (the Geffcken patent) (R. 1-5). The patent was issued on February 21, 1933, to the Radio Patents Corporation, and expired on February 21, 1950 (R. 56).

The Government contended that the patent claims in question had not been infringed and that, for several reasons, the claims were not valid (R. 49). These defenses were, in all material respects, accepted by the Commissioner of the Court of Claims, who found all of the claims invalid as anticipated by the prior art, three of the claims invalid as unsupported by the electronic circuits disclosed in the issued patent, and none of the claims infringed by the accused structures (R. 9-46). The Court of Claims agreed with the Commissioner's conclusions on non-infringement, and accordingly found it unnecessary to pass upon the patent's validity (R. 53).

The subject of the Geffcken patent is "Electric Relay Device for Indicating Weak Currents." Petitioner contended that this device was employed by the Government in various gas-containing electronic tubes and associated circuits (R. 49). In rejecting these contentions, both the Commissioner and the Court of Claims found that the evidence introduced by petitioner, principally in the form of expert testimony, did not establish that the distinctive elements of the patented invention were used in the Government's equipment. These findings (R. 53-73) may be summarized as follows:

1. The first accused structure was part of an Air Force turret controller containing a complex multitube circuit (R. 68-69). Petitioner contended that one of

the thirty or more tubes of this apparatus (a power thyratron designated *V102*), and its associated circuits (transformers, resistances, condensers), infringed all of the patent claims in suit. After reviewing the nature of the tube and its circuits, the court concluded that none of the claims had been infringed since petitioner had failed to establish that certain of its elements were contained in the structure. Specifically, the evidence was found to be inconclusive as to (a) whether the energy supply of the *V102* is of too low a value normally to cause the gas in the tube to ionize and to start an arc discharge (a luminous bow of light between two electrodes passing a relatively high value of electric current at low voltages); (b) whether the voltage on the grid of the *V102* is of such a value that the tube would become ionized and an arc discharge occur between the tube's grid and cathode upon imposition of a low additional controlling potential; (c) whether the tubes in the Air Force device provide an auxiliary discharge space formed by an auxiliary electrode, and whether an ionizing discharge exists in such space if provided; (d) whether the tubes are provided with a condenser in parallel with the main electrodes at the auxiliary gap; (e) whether the tubes have a uniform gaseous atmosphere; and (f) whether they have a potential means in the output circuit for alternately starting as well as stopping a discharge.

2. The second accused structure was the Rawin Apparatus elevation drive motor control circuit, used by the Army and providing for the control of current flow to the stator windings of a direct current motor (R. 69-71). The circuit of this device includes two gas-filled tubes designated *V603* and *V604*. Petitioner's

evidence was found to be inconclusive as to (a) whether, as with the *V102*, the voltage on the control grid is of such a value that upon imposition of a low additional controlling potential, a low voltage arc occurs between the control grid and cathode; (b) whether the tubes are glass; (c) whether the control grid is arranged to form an auxiliary discharge space together with the cathode, and whether an ionizing discharge exists in such space if provided; (d) whether the circuit includes a condenser in parallel with the main electrodes; (e) whether the tube contains a uniform gaseous atmosphere in view of the fact that mercury pool cathodes are employed; (f) whether the circuit includes an electric reactance associated with an input circuit and connected to an auxiliary electrode; and (g) whether the circuit includes potential means in the output circuit for alternately starting as well as stopping an electric discharge.

3. The third accused structure was a Navy auxiliary control panel, employing a vacuum tube marked *V19* (R. 71-72). The tube, as shown by relatively low maximum-peak current limits and high voltage drop during conduction, is a glow discharge device (a luminous glow or haze between two electrodes passing minute values of current at relatively high voltages). Accordingly, it could not be used for arc conduction as required by the patent claims. Petitioner's contention that, when used in the control panel circuit, the tube might operate in arc discharge was rejected as unsupported by the evidence. Although petitioner had called one fact witness and three expert witnesses on this point, no coherent explanation was made of the tube's operation in the circuit, or of the nature of the other

circuits or apparatus with which the relay circuit of the control panel was used. There was no evidence as to the value or values of any potentials connected to the numerous terminals and no evidence of a potential means in the output circuit for alternately starting as well as stopping the electric discharge.

4. The final accused structure was a Navy Resistance Welding Control, containing a gas-filled tube designated *4TU* (R. 72). As with the tubes contained in the first three structures, the evidence was inconclusive as to whether this tube is caused to fire by imposition of a low additional, or an extremely weak, controlling potential upon an auxiliary potential already imposed on the grid electrode. Such a possibility would be extremely remote since petitioner's own exhibit showed that the structure employs a grid bias supplied from a 60-volt source and a control potential from a 230-volt source.

5. Perhaps the most distinctive feature of the Gefficken invention is the use of a cold cathode and an external circuit which makes the cold cathode arc (R. 50). Petitioner's counsel himself pointed this out in his opening statement before the Commissioner (R. 73). The specification of the Gefficken patent does not teach the use of a hot cathode or a thermionic (heated) filament type cathode (tubes which employ thermionic means to emit electrons which provide the path for the flow of electricity). All of the accused structures, with the exception of the Navy auxiliary control panel, clearly utilize tubes having thermionic filaments providing a hot cathode. Thus, it must be concluded, an essential element of the patented invention, along with its possible advantages,

was not employed in three of the four Government devices accused.

The Navy auxiliary control panel admittedly utilizes a cold cathode but lacks the necessary circuit to produce an arc discharge. It utilizes a tube described as a vacuum tube in the manufacturer's own specifications, whereas one of the principal features of the Gefficken patent is the use of a gas-filled tube (R. 73). Thus, this control panel, too, does not infringe any of the patent claims in suit.

ARGUMENT

1. Petitioner's own statement (Pet. 5-10) of the first issue which he seeks to have determined demonstrates that he raises neither a question of general importance nor one involving a conflict of decisions requiring resolution by this Court. Rather, he seeks nothing more than to have this Court review the record, and to hold, after conducting such a review, that the findings of fact made by the Commissioner and adopted by the Court of Claims—that none of the patent claims was in fact infringed by the accused structures—are unsupported by the evidence. Furthermore, in urging that there is no basis for these findings, petitioner argues that the court below was legally required, in the absence of contrary evidence, to accept the conclusions of his expert witnesses, a contention which wholly ignores the freedom of the trier of fact to find that particular evidence is inconclusive or unpersuasive.

This Court has held that, in an infringement suit which centers upon the testimony of expert and other witnesses, questions of validity and infringement are questions of fact, not of law. *United States* v. *Esnault-*

Pelterie, 303 U.S. 26, 29-30. As to such questions, the normal limitations on appellate review of factual findings have especial significance, for "* * * so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience." *Graver Mfg. Co.* v. *Linde Co.*, 339 U.S. 605, 610.

Although it is clear that petitioner's attack on all of the findings of the court below is ill-founded, the single example chosen by petitioner from the record will serve to illustrate our point (Pet. 5-6). The Court of Claims ruled with respect to the tubes used in the Air Force turret controller (the first accused structure, pp. 3-4, *supra*), that "We are not able to find any basis for departing from our trial commissioner's finding that this controller circuit does not respond to the specific recital of claim 18," namely, "a potential means in the output circuit for alternately starting and stopping the electric discharge * * *." (R. 51; Pet. 20). In the face of this finding, petitioner points to the uncontradicted testimony of an expert witness that "The co-joint action of the shunt condenser C121 and the series resistor R119 effectuates the alternate starting and stopping of the discharge tube V107 during its firing state, namely, when the tube would tend to or want to conduct, it is alternately interrupted by those two elements * * * as the Government [sic] witness yesterday very clearly and ably set forth" (Tr. 147). But petitioner's patent expert, although later qualified as a technical expert, was not qualified to establish operation of the accused structures in the terms of the claims (Tr. 133, 632-33, 634). He relied on the testimony of another witness given on

the previous day. This reliance was quite erroneous, for that witness had stated (in answer to leading questions from petitioner's counsel) only that the discharge might be stopped sometime after it was started, not that the tube current was alternately interrupted, *i.e.*, started and stopped (Tr. 41-42).[4] And in giving this testimony, the witness asserted that whether the circuit would perform the former function "* * * is rather difficult for me to say"; "It looks very much like it would" (*ibid.*). Thus, when properly analyzed, it is plain that it was perfectly sound for the Court of Claims to conclude that the evidence was "inconclusive as to whether the controller thyratrons [have the alternate interruption means] recited in claim 18", (R. 69).

2. Petitioner's contention that the Court of Claims committed reversible error in deciding the case on the ground of non-infringement, without considering the question of the validity of the patent, misconceives *Sinclair & Carroll Co.* v. *Interchemical Corp.*, 325 U.S. 327. In that case, the District Court had held a patent invalid and non-infringed; the Court of Appeals reversed, holding the patent both valid and infringed; and this Court reinstated the District Court judgment on the ground of invalidity alone, without reaching the question of infringement (which was, of course, rendered moot by the decision). No part of the Court's holding requires, as a matter of law, that the question of validity always be considered first before a finding of non-infringement can be made. The Court simply

[4] The witness affirmatively answered the following question: "* * * you do need in the case of tube V107 something which will bring the plate voltage below the ignition point: is that correct?"

stated, in the portion of its opinion quoted by petitioner (Pet. 10-11), that since the question of validity has the greater public importance, the better practice is *usually* to inquire fully into that question. The lower federal courts have consistently given this Court's language its obvious meaning and have held this to be a cautionary admonition rather than a peremptory direction—at most, a requirement that courts strike down clearly invalid patents when it is in the public interest to do so. *E.g., Hutchens* v. *Faas*, 249 F. 2d 465, 467 (C.A. 9); *Kemart Corp.* v. *Printing Arts Research Laboratories*, 201 F. 2d 624, 634 (C.A. 9); *Dow Chemical Co.* v. *Skinner*, 197 F. 2d 807, 811-12 (C.A. 6), certiorari denied, 344 U.S. 856; *Patent Scaffolding Co.* v. *Up-Right, Inc.*, 194 F. 2d 457, 461-62 (C.A. 9), certiorari denied, 343 U.S. 958; *Harries* v. *Air King Products Co.*, 183 F. 2d 158, 161-63 (C.A. 2); cf., *Altvater* v. *Freeman*, 319 U.S. 359, 363; *Electrical Fittings Corp.* v. *Thomas & Betts Co.*, 307 U.S. 241. In the *Harries* case, *supra*, Judge Learned Hand stressed the importance of permitting a court, in its discretion, to choose the more convenient course in a particular case, since disposing of a suit on the ground of non-infringement avoids what may be the extremely difficult task of reconstructing the prior art and of attempting to resolve such vague and elusive questions as whether the prior art has been significantly improved upon. After considering this Court's decision in *Sinclair & Carroll*, Judge Hand stated, "We hold that it is open to a court to proceed as is most convenient, subject to the exception that, though the defendant has not infringed, claims may be so evidently invalid that the court should so declare." 183 F. 2d at 163.

In the present case, wholly apart from these considerations, there was a simple and clear reason for the Court of Claims to base its decision on non-infringement rather than on invalidity. As noted *supra*, p. 3, the patent in question had expired on February 21, 1950, prior to the time this suit was instituted. Obviously, any overriding consideration stemming from the public interest in an adjudication of validity or invalidity cannot be applied to a patent which has expired and long since cease to preclude the unlicensed manufacture and use of similar devices.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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IN THE

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October Term, 1958

No. 832

WILLIAM DUBILIER,

Petitioner,

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THE UNITED STATES.

PETITIONER'S REPLY BRIEF

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PETITIONER'S REPLY BRIEF

1. Because the invention here involved is a complex electronic device—an ionized gas arc discharge tube circuit —petitioner urged that the trier of facts must, as a matter of law, accept undisputed testimony unless he has special knowledge in this field.

Petitioner, through an expert, established a *prima facie* case of infringement by taking each word of a claim and applying it word for word to respondent's accused structure. Respondent did not dispute any portion of this testimony through its experts.

Respondent agrees that petitioner's testimony, namely that "potential means • • •" is present in defendant's structure, is "the uncontradicted testimony of an expert witness" (page 8, lines 21-27, respondent's brief).

The Court of Claims, despite this undisputed testimony, concluded that respondent's device does not "respond", that is, does not contain "potential means in the output circuit for alternately starting and stopping the electric discharge in said device". (Decision page 3, line 23; respondent's brief, page 8, line 17.)

Respondent in effect urges that despite this undisputed testimony, the trier of fact must have "freedom" to make findings contrary to the evidence. (Respondent's brief, page 7, line 6 from bottom.) But in the case he cites (page 8) there was contradictory testimony. This Court refused to disturb the finder's relative evaluation of such conflicting testimony. The petition on page 5 notes the distinction over conflicting testimony.

A limited number of people have knowledge in this involved electronic art,—a field in which knowledge depends upon familiarity with specific scientific principles not usually contained in the general storehouse of knowledge and experience.*

This case is thus distinguishable from a situation where the finder's own knowledge, or where common knowledge, justifies his right to ignore the testimony. Here the finder cannot rely on his own knowledge in the absence of personal qualifications as an expert in this field.

The reasonable assumption where material testimony in a technical matter is not disputed by opposing experts is that the opposing side accepts the technical expert testimony as true.

Only after the trial did respondent substitute persuasive eloquence for testimony in this technical invention—eloquence which, of course, is not subject to cross-examination to establish its errors in physics. The purposes and functions of experts have thus been destroyed.

Accordingly, instead of having a decision based on technical testimony by experts for both sides, there is here a decision based solely on counsel's physics disputing petitioner's expert's testimony.

Petitioner will be able to show that all the other substantial findings and conclusions are either unsupported

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* Here petitioner has borrowed from this Court's language in the *Esnault-Pelterie* case cited by respondent on page 8.

by any testimony, or as is more usual, contrary to the only testimony on the subject.

This is already apparent from respondent's brief. This petition is based on the contention that the findings and conclusions can find no support in the testimony.

Respondent spent the first seven pages summarizing the findings but made no attempt to refer to any testimony to show support of any one of these findings.

2. Respondent at this stage of the case belatedly seeks to inject a new issue to the effect that "petitioner's expert was not qualified to establish operation of the accused structure in terms of the claims". (Respondent's brief, page 8, line 3 from bottom.)

The record shows that petitioner's expert, an electrical engineer and a registered patent attorney, has for more than twenty years prosecuted numerous patent applications on electronic technical inventions. (Record pages 132, 133, 632-634.)

Further diversion is now undertaken by respondent in its brief, page 9. Here it undertakes to show that the petitioner's expert relied on an earlier witness. A full reading of the witness' testimony in the petition, page 5, shows respondent is in error here.

In any event, respondent agrees that this testimony on the presence of the "potential means * * *" is, undisputed. (Respondent's brief, page 8, line 21.)

3. Respondent asserts that petitioner "seeks nothing more than to have this court review the record and to hold * * * infringement" (page 7, line 16, respondent's brief).

Rather petitioner has asked for a rule of law, namely that in complex technical inventions as here, the finder of facts is bound by undisputed testimony and the findings must be supported by testimony. If this Court agrees with

this rule of law, it would seem that the case would then be remanded to the Court of Claims for findings and conclusions in accordance with such a rule of law.

Respondent's brief does not anywhere discuss this issue in the framework of a complex technical invention.

4. Had the Court considered validity, it would have learned from the prior art that the "potential means . . ." in the output circuit for alternatively starting and stopping the electrical discharge was an old and "essential" element of all gas arc discharge tubes, including the Government's gas tubes. That is why its presence in respondent's devices was not disputed.

A Court, it would seem, must review the prior art in order to learn the meaning of terms necessary to properly pass on infringement. Since it must review prior art, it has to go through the process of considering validity. While these steps may be avoided in a simple non-technical invention, this procedure is necessary in a complex technical invention.

Accordingly, petitioner has raised the second issue that where, as here, a complex technical invention is involved, the Court as a matter of law should first consider validity. Respondent does not discuss this precise issue.

Respectfully submitted,

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